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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,967	09/17/1999	JAMES IHLE	0656.0370004	9463

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WASHINGTON, DC 20005

EXAMINER

NGUYEN, QUANG

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/397,967

Applicant(s)

IHLE ET AL.

Examiner

Quang Nguyen, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003 and 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35,36,42 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35,36,45 and 46 is/are allowed.
- 6) ☒ Claim(s) 42 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Applicants' amendments filed on 8/8/03 and 11/17/03 have been entered.

Amended claims 35-36, 42 and 45-47 are pending in the present application, and they are examined on the merits herein.

#### ***Response to Applicants' arguments***

The art rejections of record are withdrawn in light of Applicants' amendment.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **This is a new ground of rejection necessitated by Applicants' amendment.**

In amended claim 47, it is unclear what is encompassed by the phrase "wherein said molecule encodes a Jak3 polypeptide that is at least 80-99% homologous to the corresponding 400 amino acid sequence of SEQ ID NO:16". How can a DNA molecule comprising a DNA sequence encoding 400 contiguous amino acids or less of a Jak 3 peptide of SEQ ID NO:16 of claim 35, also encode a Jak3 polypeptide that is at least 80-99% homologous to the corresponding 400 amino acid sequence of SEQ ID NO:16? Which 400 amino acid sequence of SEQ ID NO:16 (containing 1,099 amino acids) is

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considered to be the corresponding sequence? Furthermore, by being 80-99% homologous to any 400 amino acid sequence of SEQ ID NO:16, the isolated DNA molecule no longer encodes for 400 contiguous amino acids of a Jak 3 peptide of SEQ ID NO:16, the limitation required by the amended claim 35. Therefore, the metes and bounds of this claim are not clearly determined.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Amended claim 42 is still rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,136,595 for the same reasons already set forth in the previous Office Action mailed 5/9/03 (pages 9-10).

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***Responses to Arguments***

Applicants' argument related to the above rejection in the Amendment filed on 8/8/03 (pages 10-11) has been fully considered, but it is not found persuasive.

Applicants argue simply that the claim of the current application is not obvious in view of the claims of U.S. patent No. 6,136,595. Applicants' argument is respectfully found unpersuasive because an isolated DNA molecule (a double strand molecule) comprising a DNA sequence encoding a JAK3 kinase amino acid sequence sequence of SEQ ID NO:16 or a JAK 3 kinase that is at least 80% or at least 80-99% or at least 95% homologous to the amino acid sequence of SEQ ID NO:16 of the issued U.S. Patent contains the non-coding or complementary strand that would hybridize to a DNA sequence encoding amino acids of a JAK 3 peptide of SEQ ID NO:16, wherein said peptide contains the Jak3 autophosphorylation site, under the recited stringent conditions, particularly the non-coding or complementary strand of the isolated DNA molecule of the issued U.S. Patent has at least 50 contiguous nucleotides complementary to the DNA sequence recited in claim 42 of the present application.

***Conclusions***

***Claims 35-36 and 45-46 are allowed.***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (571) 272-0776.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, David Guzo, Ph.D., may be reached at (571) 272-0767, or SPE, Irem Yucel, Ph.D., at (571) 272-0781.

**To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1636.**

*Quang Nguyen, Ph.D.*

  
DAVID GUZO  
PRIMARY EXAMINER